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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,478	05/16/2006	Bruno Aeberhard	3677	8486
7590 Striker, Striker & Stenby 103 East Neck Road Huntington, NY 11743		01/28/2008	EXAMINER LOPEZ, MICHELLE	
			ART UNIT 3721	PAPER NUMBER
			MAIL DATE 01/28/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/579,478

Applicant(s)

AEBERHARD, BRUNO

Examiner

Michelle Lopez

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

This action is in response to the amendment filed on 11/21/07.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 8, line 3, "in the same direction" renders the claim indefinite because two directions are defined previously in the claim; perhaps such should be changed to --along a same direction--.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Prell et al. (USPN 7,134,508).

Prell disclosed a power tool comprising a motor (not shown numerically) inherently coupled to a drive shaft 64, a planetary gear 74, a tool receptacle as shown in fig. 3, a fan 68 located upstream the motor for generating a cooling air stream that cools the planetary gear as

shown in col. 3, lines 61-64 (claim 1). The fan 68 is integrated with the planetary gear 74 via pinion shaft 70 (claim 2) and is located between the motor at the vicinity of 64 and a gear stage of the planetary gear 74 as shown in fig. 2 (claim 3). The fan 68 is located at the vicinity of a gear wheel of the planetary gear (claim 7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prell et al. (USPN 7,134,508) in view of Sakurai (JP 09-011158).

Prell discloses the concept of a power tool having a radial fan for cooling a planetary gear, but fails to disclose wherein said fan generates a cooling air stream flowing through the planetary gear. Sakurai shows a power tool having a motor 5, a fan 7 located upstream the motor, and a speed reduction mechanism with a gear arrangement, wherein said fan is configured to generate an axially air stream flowing through said gear arrangement for cooling purposes as shown in the Abstract. The substitution of one known element (a fan which generates axial air stream as shown in Sakurai) for another (a fan which generates radial air stream as shown in Prell) would have been obvious to one of ordinary skill in the art at the time of the invention since the substitution of the fan in Sakurai would have yielded predictable results, namely, generating an axially air stream flowing through the planetary gear in Prell for cooling purposes.

Sakurai also shows a housing having first and second ventilation openings 13, 14, at least one ventilation conduit 18, which extends continuously from the first opening through the gear arrangement to the second opening (claim 5). A coupling region 3 and at least one ventilation conduit 18 that extends from the coupling region 3 to the motor (claim 6). The fan generates an air stream directed in a radial direction relative to said fan and includes deflection means via 3, 16 for deflecting the air stream in an axial direction through conduit 18.

Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prell et al. (USPN 7,134,508) in view of Nishikawa et al. (USPN 6,779,612).

Prell discloses a power tool with a fan configure to generate air stream for cooling a planetary gear, but fails to disclose wherein the fan rotates in two directions of rotation and generates an air stream in a same direction independent from the direction of rotation of said fan. Nishikawa teaches the concept of a power tool having a motor and a fan assembly rotatable in two directions of rotation, i.e. forward and reverse, wherein in both directions of rotation said fan generates an air stream in a same axial direction along a housing 3 and passing through the motor for the purpose of effectively cooling the motor when it rotates in either direction (see col. 1, lines 6-10 and col. 3, lines 1-4). The substitution of one known element (a fan rotatable in two directions as shown in Nishikawa) for another (a fan rotatable in one direction as shown in Prell) would have been obvious to one of ordinary skill in the art at the time of the invention since the substitution of the fan shown in Nishikawa would have yielded predictable results, namely, generation of air stream in a same axial direction through the planetary gears of Prell to cool said planetary gear independently of the direction of rotation of said fan.

With respect to claim 9, Nishikawa also shows wherein the fan has blades 2 with at least two faces, one face facing to a first direction of rotation 10 and the other face facing to a second direction of rotation opposite to the first direction of rotation, wherein both blade faces direct air at least partly in a same axial direction along the housing 3 as broadly claimed.

Response to Arguments

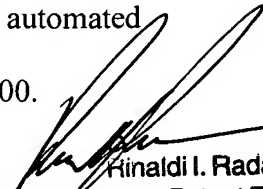
Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 571-272-4464. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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Group 3700